PTO/SB/21 (12-08)
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TRANSMITTAL FORM

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Total Number of Pages in This Submission: 17

Application Number	10/528,687
Filing Date	03/21/2005
First Named Inventor	Marie-Christine Wolf
Art Unit	1615
Examiner Name	Sasan, Aradhana
Attorney Docket Number	PA/4-32689A

ENCLOSURES *(Check all that apply)*

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☑ Amendment/Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Reply to Missing Parts/ Incomplete Application
  - ☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) _____
  - ☐ Landscape Table on CD
- ☐ After Allowance Communication to TC
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
- ☐ Proprietary Information
- ☐ Status Letter
- ☐ Other Enclosure(s) (please identify below):

Remarks

This Amendment/Response is being sent via facsimile

571-273-8300

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Montgomery, McCracken, Walker & Rhoads		
Signature	Kristin Mazany Nevins		
Printed name	Kristin Mazany Nevins		
Date	22 January 2009	Reg. No.	56,775

CERTIFICATE OF TRANSMISSION/MAILING

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Signature	Kristin Mazany Nevins		
Typed or printed name	Kristin Mazany Nevins	Date	21 January 2009

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ratios disclosed in Katzender are from 10:90 to about 80:20, which are outside the present invention and teach away from the weight ratio claimed by the Applicant. Applicant respectfully submits that it would not therefore have been obvious to one of ordinary skill in the art at the time the invention was made to modify the weight ratio to those claimed by the Applicant.

Here, Applicant has surprisingly found, after exhaustive testing, an oral dosage form of oxcarbazepine which can be administered once per day and which produces constant plasma levels of the monohydroxy derivate of oxcarbazepine (10,11-dihydro-10-hydroxy-5H-dibenz[b,f]azepine-5-carboxamide, referred to as MHD) over a twenty-four (24) hour period. Applicant respectfully asserts that one skilled in the art would not be led from the delivery system disclosed by Katzender because the modified release formulation discovered by Applicant.

In response, Applicant has amended Claim 8. For the reasons stated above, the prior art of Katzender and Eibl, either alone or in combination, fail to teach or suggest the required elements of Applicant's claimed invention, and Applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) is therefore overcome.

VII. Double Patenting

The Examiner has rejected claims 1–13 on the ground of nonstatutory obviousness-type double patenting over claims 1–9, 12–13 and 15–16 of co-pending Application No. 10/598,553 in view of Katzhendler et al. (US 6,296,783).

In making the nonstatutory obviousness-type double patenting rejection, the Examiner cites a co-pending application that, according to USPTO records available via PAIR, has not yet been examined. Thus, patentable subject matter has not yet been identified in co-pending Application No. 10/598,553.

Pursuant to MPEP §804, the Examiner may continue to make a double-patenting rejection in each pending application as long as there are conflicting claims in more than one application — unless the double patenting rejection is the only rejection remaining in at least one of the applications. At that point, a terminal disclaimer would be required to bring either case to allowance, but it appears that prior to that point a terminal

disclaimer is premature and not required prior to the identification of allowed claims. As understood by Applicant, the MPEP does not expressly require Applicant to respond to the obviousness-type double patenting rejection with a terminal disclaimer until the time at which claims are otherwise allowed and the double patenting rejection is the only rejection remaining.